



#7/BM
3-3-03

Attorney Docket No. SPO-594
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
) Group Art Unit: 1731
SEKINO; USHIODA; FUJINAMI;)
IWAMOTO) Examiner: C. FIORILLA
)
Serial No. 09/831,709)
)
Filed: May 14, 2001)

For: **METHOD OF PREPARING A CERAMIC ARTIFICIAL
CROWN AND A PREPARATION KIT USED THEREFOR**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action bearing a mail date of January 27, 2003. The one-month shortened statutory period for response is set to expire on February 27, 2003. Accordingly, this response is timely filed.

In view of the following remarks, Applicants respectfully request the Examiner to withdraw the pending restriction requirement.

SUMMARY OF RESTRICTION REQUIREMENT
AND SPECIES ELECTION

The Restriction Requirement states as follows:

Restriction to one of the following

RECEIVED
FEB 27 2004
TC 1700 MAIL ROOM

inventions is required under 35 U.S.C. 121:

I. Claims 1, 2, and 16-35, drawn to a method of preparing a crown.

II. Claims 12 and 13, drawn to a dental porcelain.

III. Claim 14, drawn to a kit for preparing a crown.

IV. Claim 15, drawn to a kit for imparting color.

PROVISIONAL ELECTION

Applicants provisionally elect with traverse Group I (claims 1-2 and 16-35) drawn to a method of preparing a crown as stated in the Restriction Requirement.

However, Applicants respectfully submit that at the very least, Group III claims (drawn to a kit for preparing a crown) should be prosecuted with Group I claims (drawn to a method for preparing a crown).

In the event the Restriction is not overcome, Applicants preserve the right to pursue the subject matter of the unelected claims in later applications.

TRAVERSAL

Applicants respectfully traverse the Examiner's Restriction

Requirement as to Groups I-IV and elect Group I claims. If the Examiner is not persuaded by the traversal with regard to Group I-IV claims, Applicants contend that at the very least, they are entitled to examination of Group I and III claims within a single application.

The touchstone for requiring restriction is determining whether two or more independent and distinct inventions are claimed within the same application. MPEP §806. Restriction should never be required where the claims of an application define the same essential characteristics of a single disclosed embodiment of the invention. MPEP §806.03.

Furthermore, it has been held that in a national stage application filed under 35 U.S.C. § 371, the Examiner **must** apply PCT Rule 13.2 in determining unity of invention. Caterpillar Tractor Co. v. Comm. Of Patents and Trademark, 650 F.Supp. 218; 231 U.S.P.Q. 590 (E.D.Va.1986); See MPEP §1850.

PCT Rule 13.2 in turn states that unity of invention exists where the claimed inventions share one or more special technical features. Id. The term special technical feature is defined as those technical features that define a contribution which each of the inventions considered as a whole, makes over the prior art. Id.

In the present application, Groups I-IV share the same technical feature.

Alternatively, Groups I and III share the same technical feature of an assembly comprising a crucible former having a pole member formed on the central portion of a cylinder. In particular, claim 1 recites:

. . . a crucible former having a pole member formed on the central portion of a cylinder with a bottom . . .

While claim 14 similarly recites:

. . . a crucible former having a pole member formed on the central portion of a cylinder with a bottom . . .

Clearly, Group I and III claims share a common technical feature.

Accordingly, Applicants respectfully request that the Restriction be withdrawn or alternatively that the Restriction with respect to Group I and III claims be withdrawn.

CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and to examine all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

SHERMAN & SHALLOWAY

A handwritten signature in black ink, appearing to read "Roger C. Hahn", is written over a horizontal line.

Attorney for Applicants
Roger C. Hahn
Reg. No. 46,376

SHERMAN AND SHALLOWAY

P.O. Box 788
Alexandria, Virginia 22313
(703) 549-2282